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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/444,660	11/22/1999	EDWARD J. PETRUS		8939

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EDWARD J PETRUS
3413 SPANISH OAK DR
AUSTIN, TX 78731

EXAMINER

PORTER, RACHEL L

ART UNIT	PAPER NUMBER
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3626

DATE MAILED: 11/18/2002

10

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/444,660

Applicant(s)

PETRUS, EDWARD J.

Examiner

Rachel L. Porter

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--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 17 October 2002 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
- b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. **ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).**

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☐ they raise the issue of new matter (see Note below);
 - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____

3. ☒ Applicant's reply has overcome the following rejection(s): 112, 2nd paragraph rejections of claims 2 and 3.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Attached Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

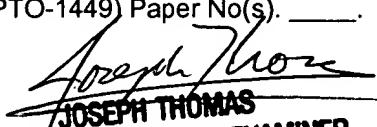
Claim(s) allowed: none.

Claim(s) objected to: none.

Claim(s) rejected: 1-5.

Claim(s) withdrawn from consideration: none.

8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
10. ☐ Other: _____


JOSEPH THOMAS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600

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Attachment to Advisory Action—Paper No. 10

Continuation of Item # 5

(A) On page 1 of the response filed 10/17/02, the Applicant argues that the amendment in response to the Non-Final Action (Paper No. 3, mailed March 20, 2002) was filed on June 11, 2002 and that no new amendments were made in the June 24, 2002 response “as claimed by the Examiner.”

In response, the Examiner respectfully reminds the Applicant that the Applicant's first response filed on June 11, 2002 was non-compliant because it failed to meet the requirements under 37 C.F.R. 1.121 (b)(1)(i) and (ii). The Applicant's response to the Office Communication mailed on 6/13/02 (Notice of Non-Compliant Amendment, Paper No. 5), was received by the Office on June 24, 2002. While no additional changes or amendments were made to the text of claims, abstract, or summary of the invention in the June 24, 2002 response, this second response is considered a supplemental amendment (i.e. supplemental to the June 11, 2002 amendment) which places the original amendment in proper condition for examination purposes. For simplicity and clarity, the Examiner refers to the Applicant's first (non-compliant) and second (compliant) responses to the Non-Final Rejection (Paper No. 3) as the “amendments filed on 6/11/02 and 6/24/02.”

(B) On pages 1- 2 of the response filed 10/17/02, the Applicant argues that the Final Rejection (Paper No. 8, mailed 9/1/02) is improper because new grounds of rejection were introduced.

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In response, the Examiner respectfully disagrees, as the amendments filed by Applicant on 6/11/02 and 6/24/02 changed the scope of the originally claimed invention. Thus, the amendment to claim 1 required further consideration of the prior art so as to necessitate new grounds of rejection, in accordance with MPEP § 706.07(a). With reference to independent claim 1, it is clear that the amendment to claim 1 in the Applicant's 6/11/02 and 6/24/02 responses involves a significant modification to the process of the originally filed claim 1. For instance, amended claim 1 adds the new step of "adjusting for differences in the individual's health information when compared to an optimal health profile" before generating the dietary supplement profile. As such, the Examiner respectfully submits that a considerable change in scope clearly exists between the process that was originally claimed and that presented in the 6/11/02 and 6/24/02 amendments. The extent to which Applicant had amended the originally filed claim 1 caused the Examiner to reconsider the rejection made in the first Office Action. Wherein the previously claimed subject matter was thoroughly searched and was found to be anticipated by Summerell et al, the newly amended claim required the Examiner to further search for and apply a new reference (i.e., Riley), given the new feature and limitation of amended claim 1 that was not present in the originally filed claim 1. The Examiner respectfully submits that the incorporation of a new step into claim 1 was clearly a significant change to the scope of the invention as originally claimed that could not be anticipated by the Examiner and, as such, necessitated a new grounds of rejection, in accordance with MPEP § 706.07(a).

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Thus, for at least the reasons given above, it is the position of the Examiner that, contrary to the Applicants arguments in the 10/17/02 response (page. 2, lines 16-17), the amendments filed by Applicant on 6/11/02 and 6/24/02 were NOT the same subject matter as originally filed.

Moreover, the Examiner's decision to make the prior Office action a Final rejection was not premature or improper in it was the second action on the merits of the instant application. MPEP § 706.07(a) gives the following guidance:

"Due to the change in practice as affecting final rejections, older decisions on questions of prematurity of final rejection or admission of subsequent amendments do not necessarily reflect present practice.

Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p)." (emphasis added)

In further arguing that the Final Rejection (Paper No. 8) is improper, the Applicant cites the following section of the Final rejection: "The Applicant's arguments filed 6/24/02 have been fully considered but they are not persuasive." (page 9, lines 14-15 of Paper No. 8) It was not the Applicant's arguments but rather the Applicant's amendment to the originally filed claim 1 that necessitated the new grounds of rejection provided in the Final Rejection. The Examiner addressed the Applicant's arguments as an attempt to further assist the Applicant

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in understanding Examiner's interpretation of the prior art as applied to the originally filed claims.

In the present application, since the amendments filed on 6/11/02 and 6/24/02 clearly necessitated the new grounds of rejection for the reasons given above, it was proper (and even required) that the second Office Action be final.

(C) On pages 5-7 of the Applicant's response filed 10/17/02, the Applicant relies on unclaimed features to allege that the claimed invention patentably distinguishes itself over the prior art of record.

In response, the Examiner respectfully reminds the Applicant that the Examiner searches and considers prior art based on how it reads on the invention *as the invention is claimed*. Furthermore, additional searches are required and other prior art must be considered each time the Applicant amends the claims to include limitations not previously included in the original claim language. It is respectfully submitted that the Applicant fails to understand the vast breadth of the Applicant's chosen claim language.

While the Examiner acknowledges that the prior art of record may or may not include each limitation of the invention *as disclosed in the Applicant's specification*, Examiner submits the claimed limitations of the invention have been shown to be either fully disclosed or obvious over the art of record as explained the Non-final Rejection (Paper No. 3) and/or the Final Rejection (Paper No. 8) provided to the Applicant. The Applicant apparently ignores the evidence given by the Examiner, namely, specific portions of each applied reference, express articulations of the combinations and motivations for combinations, as

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well as the scientific and logical reasoning of one skilled in the art at the time of the Applicant's invention, as provided in the previous detailed Office Actions (Paper Numbers 3 and 8).

(D) On pages 6-9 of the Applicant's response filed 10/17/02, the Applicant alleges that the Examiner has failed to establish a *prima facie* case of obviousness and that the combination of references applied against the claims is improper. Furthermore, the Applicant uses several court cases to argue that a *prima facie* case of obviousness has not been clearly and properly established.

In response to Applicant's concern that the Examiner has ignored or misapplied the mandate of the modern case law which clearly and explicitly hold that in order for the references to be combined in that the references must explicitly teach or suggest every element of the combination as well as how to use such a combination, the Examiner respectfully submits that Applicant misinterprets some of the case law cited.

The Examiner recognizes that references cannot be arbitrarily altered or modified and that there must be some reason why one skilled in the art would be motivated to make the proposed modifications. While the Examiner acknowledges that the motivation or suggestion to make modifications must be articulated, it is respectfully submitted that there is no requirement that the motivation to make modifications must be expressly articulated within the references themselves. The Examiner is concerned that the Applicant apparently overlooks the mandate of the numerous court decisions supporting this position. References are evaluated by what they suggest to one versed in

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the art, rather than by their specific disclosures, *In re Bozek*, 163 USPQ 545 (CCPA 1969). The issue of obviousness is not determined by what the references expressly state but by what they would reasonably suggest to one of ordinary skill in the art, as supported by decisions in *In re DeLisle* 406 Fed 1326, 160 USPQ 806; *In re Kell, Terry and Davies* 208 USPQ 871; and *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ 2d 1596, 1598 (Fed. Cir. 1988) (citing *In re Lalu*, 747 F.2d 703, 705, 223 USPQ 1257, 1258 (Fed. Cir. 1988)).

Further, it was determined in *In re Lamberti et al*, 192 USPQ 278 (CCPA) that:

- (i) obviousness does not require absolute predictability;
- (ii) non-preferred embodiments of prior art must also be considered; and
- (iii) the question is not express teaching of references, but what they would suggest.

According to *In re Jacoby*, 135 USPQ 317 (CCPA 1962), the skilled artisan is presumed to know something more about the art than only what is disclosed in the applied references. In *In re Bode*, 193 USPQ 12 (CCPA 1977), every reference relies to some extent on knowledge of persons skilled in the art to complement that which is disclosed therein.

According to *Ex parte Berins*, 168 USPQ 374 (Bd. Appeals), there is no statutory limitation as to the number of references that may be used to demonstrate obviousness...not what references expressly state but what they would reasonably suggest to one of ordinary skill in the art. In *In re Conrad*, 169

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USPQ 170 (CCPA), obviousness is not based on express suggestion, but what references taken collectively would suggest.

In the instant case, the Examiner respectfully notes that the motivation to combine the applied references used for the art rejection of claim 1 are accompanied by select portions of the respective reference(s) which specifically support that particular motivation. As such, it is NOT seen that the Examiner's combination of references is unsupported by the applied prior art of record. Rather, it is respectfully submitted that explanation based on the logic and scientific reasoning of one ordinarily skilled in the art at the time of the invention that support a holding of obviousness has been adequately provided by the motivations and reasons indicated by the Examiner.

With respect to Applicant's argument that the Summerell et al and Riley combination is improper and that the Riley reference teaches away from the combination supplied in the rejection of claim 1, the Examiner respectfully submits that the Applicant appears to view the applied references, separately and in a vacuum, without considering the knowledge of average skill in the art, and further fails to consider the teaching and suggestions of the Riley reference, as detailed in the Final Rejection (Paper No. 8). In particular, the Riley reference suggests that a principle purpose of the invention is to fulfill the need for ". . . a nutritional system which supplies the right amount of micronutrients at the right time to help prevent the problems commonly seen with vitamin supplementation . . ." (col. 4, lines 32-47).

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Moreover, the issue at hand is not whether the applied references specifically teach the same combination of a method of generating dietary supplement profiles recited by Applicant, *per se*, but rather, whether or not the prior art, when taken in combination with the knowledge of average skill in the art, would put the artisan in possession of the features as claimed. Regarding this issue, the courts have held that even if a patent does not specifically disclose a particular element, said element being within the knowledge of a skilled artisan, the patent taken in combination with that knowledge, would put the artisan in possession of the claimed invention. *In re Graves*, 36 USPQ 2d 1697 (Fed. Cir. 1995).

Continuation of Item # 7

Claims 1-5 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Summerell et al (US Patent No. 5,937,387) in view of Riley (US Patent No. 5,976,568) for the same reasons set forth in the prior detailed Office Action, the Final Rejection mailed 9/11/02, and as further explained in the responses to the Applicant's arguments given above.

Although the amendments to claims 2 and 3 are sufficient to overcome previous rejections of claims 2-3 under 35 U.S.C. 112, 2nd paragraph, the amendments are not sufficient to overcome the rejections of these claims based on the prior art references of Summerell et al and Riley, as explained in the previous detailed Office Action and the responses to the Applicant's arguments given above.

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As such, the prior art rejections of claims 1-5 are maintained.